

TRANSMITTAL OF APPEAL BRIEF (Large Entity)Docket No.
3731In Re Application Of: **BERGNER, J.**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/585,048	06/29/2006	OMAR, A.	278	2838	6190

Invention: **DEVICE WITH A POWER TOOL CASE****COMMISSIONER FOR PATENTS:**

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

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Examiner: Omar, A.

Art Unit: 2838

Docket No. 3731

In re:

Applicant: BERGNER, J.

Serial No.: 10/585,048

Filed: June 29, 2006

APPEAL BRIEF

March 1, 2007

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sirs:

The Appellant submits the following for his brief on appeal and respectfully request consideration of same. The Appellant requests withdrawal of the rejections made and that the Application be placed in line for Allowance.

TABLE OF CONTENTS

I.	REAL PARTY IN INTEREST	3
II.	RELATED APPEALS AND INTERFERENCES	3
III.	STATUS OF CLAIMS	3
IV.	STATUS OF AMENDMENTS	3
V.	SUMMARY OF CLAIMED SUBJECT MATTER	3 - 4
VI.	GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL	4
VII.	ARGUMENT	5 - 9
VIII.	CLAIMS APPENDIX	10 - 13
IX.	EVIDENCE	14
X.	RELATED PROCEEDINGS	15

I. REAL PARTY IN INTEREST

The real party in interest in the instant application is the assignee of the application, Robert Bosch GmbH, Stuttgart, Germany.

II. RELATED APPEALS AND INTERFERENCES

The Appellant is unaware of any related appeals or interferences with regard to the application.

III. STATUS OF CLAIMS

Claims 1-12 and 14-20 are rejected. Claim 13 is canceled. Claims 1-12 and 14-20 are appealed.

IV. STATUS OF AMENDMENTS

A Final Office Action finally rejecting claims 1-20 was mailed on January 28, 2009. A Request for Continued Examination (RCE) and Preliminary Amendment were submitted on April 20, 2009, in which claim 1 was amended and claim 13 was canceled. A non-final Office Action was mailed on May 8, 2009 in response to the RCE and Preliminary Amendment. The prior rejection of the claims was maintained.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 defines a device with a power tool case (10) that includes at least one first receiving area (12) for a power tool (16), and a charger (14) (specification, page 4, first paragraph; Fig. 1). The charger (14) and the power tool case (10) are

designed to remain connected during a charging procedure (page 5, lines 7-9; Figs. 2 and 3). The power tool is stored in a transport position in the at least one first receiving area and is arranged in a second receiving area during the charging procedure in a standing position (page 4, lines 9-17; Figs. 2 and 3). The second receiving area is embodied as a stand (page 4, lines 9-10; Figs. 2 and 3) and comprises charging contacts to transmit charging energy (page 4, lines 18-23; Figs. 2 and 3).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1, 2, 6, 7, 11 and 20 are unpatentable under 35 U.S.C. 103(a) over GB 2397704 A to Mather et al ("Mather") in view of U.S. Patent No. 6,066,938 to Hyodo ("Hyodo");
2. Whether claims 1, 3, 4, 5, 7-10, 12, 14-15, and 19 are unpatentable under 35 U.S.C. 103(a) over U.S. Patent No. 6,571,949 to Burrus, IV ("Burrus") in view of Hyodo;
3. Whether claim 16 is unpatentable under 35 U.S.C. 103(a) Burrus, in view of Hyodo and further in view of U.S. 2003/0150756A1 to Kajiya.
4. Whether claims 17 and 18 are unpatentable under 35 U.S.C. 103(a) Burrus, in view of Hyodo and further in view of U.S. Patent No. 6,682,361 to Zweigle ("Zweigle").

VII. ARGUMENT

1. **Claims 1, 2, 6, 7, 11 and 20 are patentable over the combination of Mather and Hyodo.**

The present application claims a device with a power tool case (10), that includes at least one first receiving area (12) for a power tool (16), and a charger (14), wherein the charger (14) and the power tool (16) are designed to remain connected during a charging procedure and wherein said power tool (16) is stored in its transport position in said first receiving area (12) and *wherein said power tool (16) is arranged in a second receiving area (26) during said charging procedure in a standing position.*

Neither Mather nor Hyodo et al discloses or teaches a device with a power tool case with a *first receiving area and a second receiving area*, wherein the power tool is stored in a transport position *in the first receiving area* and wherein the power tool is arranged in a *second receiving area* during a *charging procedure* in a standing position as defined in claim 1. Due to the structure according to claim 1, it can be easily detected by an operator or even by any bypassing person, whether the power tool (16) is being charged (standing position) or is stored for the purpose of transportation (lying position). If the power tool (16) is located in the first receiving area (12), the tool (16) is stored for transportation. However, if the power tool (16) is arranged in the second receiving area (26), indicated by the standing position of the power tool (16), the power tool (16) and a charger (14) are in the recharging mode. Therefore, a construction or arrangement can be provided which is very operator friendly and which can indicate its present condition with less effort.

Mather discloses providing a case (1) with one storage area for a power tool in the event of transportation and storage, respectively (see Mather, Fig. 1 and page 1, lines 1 to 3).

Hyodo et al teaches arranging an impact screwdriver (1) in an upright position in a charger (20) (see Hyodo et al, Fig. 10, and the abstract).

Thus, each of the cited references shows only one receiving area. Whereas Hyodo et al. might show that the power tool can be stood in the area during charging, this does not support modification of either of the primary references to add a second receiving area for this purpose.

Instead Hyodo et al would only lead the practitioner to modify Mather al to provide one receiving area in which the tool could be charged in a standing position rather than stored in a lying position, since likewise, neither Mather nor Hyodo proposes two receiving areas.

The Applicant therefore respectfully submits that a *prima facie* case of obviousness is not established by the cited reference combination, since the prior art does not suggest the desirability of the claimed invention (MPEP section 2143.01). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

2. Claims 1, 3, 4, 5, 7-10, 12, 14-15, and 19 are patentable over Burrus in combination with Hyodo.

As argued above, Mather does not disclose or teach a device with a power tool case with a *first receiving area and a second receiving area*, wherein the power tool is *stored in a transport position in the first receiving area* and wherein the power tool is arranged in a *second receiving area* during a *charging procedure* in a standing position as defined in claim 1. Due to the structure according to claim 1, it can be easily detected by an operator or even by any bypassing person, whether the power tool (16) is being charged (standing position) or is stored for the purpose of transportation (lying position). If the power tool (16) is located in the first receiving area (12), the tool (16) is stored for transportation. However, if the power tool (16) is arranged in the second receiving area (26), indicated by the standing position of the power tool (16), the power tool (16) and a charger (14) are in the recharging mode. Therefore, a construction or arrangement can be provided which is very operator friendly and which can indicate its present condition with less effort.

Mather discloses providing a case (1) with one storage area for a power tool in the event of transportation and storage, respectively (see Mather, Fig. 1 and page 1, lines 1 to 3).

In Burrus et al especially, no suggestion is provided which would have led someone skilled in the art to arrange the power tool (104) in a standing position during charging or to provide a second receiving area for charging the power tool (104) in a standing position. Since the Burrus et al reference specifically discloses arranging the power tool (104) in a lying position during charging it could not be seen why a person skilled in the art should change this arrangement.

Indeed, such a modification actually contradicts the Burrus disclosure, because the charging of the power tool (104) is performed during the transport and thus when the vehicle is moving. A standing arrangement of the power tool (104) would be very unstable and would lead to an unreliable transport and charging of the power tool (104). This would not only affect the charging result but also the work of the people who operate with the insufficiently charged power tool (104).

Moreover, this unstable transport situation could also result in a damage of the power tool (104) when falling out of the charger during transport. Thus, someone skilled in the art would not consider arranging the power tool (104) in a standing position during charging.

Further, neither of the cited references discloses that a *second receiving area is embodied as a stand and comprises charging contacts to transmit charging energy*

The Applicant therefore respectfully submits that a *prima facie* case of obviousness is not established by the cited reference combination, since the prior art does not suggest the desirability of the claimed invention (MPEP section 2143.01). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

3. Claim 16 is patentable over the combination of Burrus, in view of Hyodo and further in view of Kajiya.

Because claim 16 depends ultimately from independent claim 1, and therefore includes all of the features of claim 1, claim 16 is patentable for the same reasons as set forth above with regard to claim 1.

4. Claims 17 and 18 are patentable over the combination of Burrus, in view of Hyodo and further in view of Zweigle.

Because claims 17 and 18 depend ultimately from independent claim 1, and therefore includes all of the features of claim 1, claims 17 and 18 are patentable for the same reasons as set forth above with regard to claim 1.

In view of the foregoing discussion, it is respectfully requested that the Honorable Board of Patent Appeals and Interferences overrule the final rejection of claims 1-12 and 14-20 over the cited art, and hold that Appellant's claims be allowable over such art.

Respectfully Submitted,



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VIII. CLAIMS APPENDIX

Copy of Claims Involved in the Appeal:

1. A device with a power tool case (10), that includes at least one first receiving area (12) for a power tool (16), and a charger (14),
wherein the charger (14) and the power tool case (10) are designed to remain connected during a charging procedure, wherein said power tool is stored in a transport position in said at least one first receiving area, wherein said power tool is arranged in a second receiving area during said charging procedure in a standing position, and wherein said second receiving area is embodied as a stand and comprises charging contacts to transmit charging energy.
2. The device as recited in Claim 1,
wherein the power tool case (10) includes installation space (24) for the charger (14), and the charger (14) is designed to remain in the installation space (24) of the power tool case (10) during the charging procedure.
3. The device as recited in Claim 1, wherein the connection between the charger (14) and the power tool case (10) is designed to be detachable.
4. The device as recited in Claim 3, wherein the charger (14) is connected with the power tool case (10) via at least one detachable fastening means (18).

5. The device as recited in Claim 4, wherein the fastening means (18) is designed to be actuated without the use of tools.

6. The device as recited in Claim 1, wherein the charger (14) includes a wind-up device (20) for a power cord (22).

7. A charger (14) for a device as recited in Claim 1.

8. The charger (14) as recited in Claim 7, characterized by the fact that it is designed as a stand for the power tool (16).

9. The charger (14) as recited in Claim 8, characterized by a receiving area (26) in which the power tool (16) is positioned at least substantially in the machining direction (28).

10. The charger (14) as recited in Claim 8, characterized by a coupling unit (30) that is designed to correspond with a coupling unit (32) of a power tool unit (16) while the stand function is being performed and to at least transmit charging energy.

11. A power tool case (10) for a device as recited in Claim 1.

12. The device as recited in claim 1, wherein said power tool is stored in the transport position in said first receiving area in a lying position.

14. The device as recited in claim 1, wherein said power tool projects above a half of said power tool case when said power tool is arranged in the second receiving area.

15. The device as recited in claim 14, wherein said power tool case is reliably prevented from being closed during said charging procedure due to the standing position of said power tool.

16. The device as recited in claim 3, wherein a connecting means for the connection between the charger and the power tool case is embodied as a flexible flap integrally mounted to said power tool case.

17. The device as recited in claim 4, wherein said fastening means is embodied as a detent element.

18. The device as recited in claim 17, wherein said detent element is embodied as a latching hook.

19. The device as recited in claim 4, wherein said fastening means extends through a recess in a housing wall of said power tool case.

20. The device as recited in claim 6, wherein said wind-up device comprises a rotatably supported storage means located underneath a receiving area of the charger.

IX. EVIDENCE APPENDIX.

None.

X. RELATED PROCEEDINGS APPENDIX.

None.